UNITED STATES PATENT AND TRADEMARK OFFICE

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DITTHAVONG MORI & STEINER, P.C.
918 Prince St.
Alexandria, VA 22314

EXAMINER
CHANDLER, SARA M

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
10/800,270</td><td>Applicant(s)
GILMORE, NORMAN</td></tr>
<tr><td>Examiner
SARA CHANDLER</td><td>Art Unit
3693</td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _____.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-19* is/are pending in the application.
      4a) Of the above claim(s) *19* is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-18* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
      Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
      Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
      a)☐ All b)☐ Some * c)☐ None of:
          1.☐ Certified copies of the priority documents have been received.
          2.☐ Certified copies of the priority documents have been received in Application No. _____.
          3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
      * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
      Paper No(s)/Mail Date *06/14/04*.

4) ☐ Interview Summary (PTO-413)
      Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

Response to Amendment

Applicant's election of group I, claims 1-18 in the reply filed on 05/20/09 is

acknowledged. Because applicant did not distinctly and specifically point out the

supposed errors in the restriction requirement, the election has been treated as an

election without traverse (MPEP § 818.03(a)).

Claim Interpretation

1. In determining patentability of an invention over the prior art, all claim limitations

have been considered and interpreted as broadly as their terms reasonably allow. See

MPEP § 2111.

> Although the claims are interpreted in light of the specification, limitations from
> the specification are not read into the claims. See *In re Van Geuns*, 988
> F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

> Applicant always has the opportunity to amend the claims during prosecution,
> and broad interpretation by the examiner reduces the possibility that the claim,
> once issued, will be interpreted more broadly than is justified. *In re Pruter*, 415
> F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See MPEP § 2111.

2. All claim limitations have been considered. Additionally, all words in the claims have

been considered in judging the patentability of the claims against the prior art. See

MPEP 2106 II C. The following language is interpreted as not further limiting the scope

of the claimed invention. See MPEP § 2106 II C.

Language in a method claim that states only the intended use or intended result,

but the expression does not result in a manipulative difference in the steps of the claim.

Language in a system claim that states only the intended use or intended result, but

does not result in a structural difference between the claimed invention and the prior art.

In other words, if the prior art structure is capable of performing the intended use, then it

meets the claim.

Claim limitations that contain statement(s) such as "*if, may, might, can could*", as

optional language. As matter of linguistic precision, optional claim elements do not

narrow claim limitations, since they can always be omitted.

Claim limitations that contain statement(s) such as "*wherein, whereby*", that fail to

further define the steps or acts to be performed in method claims or the discrete

physical structure required of system claims.

> USPTO personnel should begin claim analysis by identifying and evaluating each
> claim limitation. For processes, the claim limitations will define steps or acts to
> be performed. For products, the claim limitations will define discrete physical
> structures or materials. Product claims are claims that are directed to either
> machines, manufactures or compositions of matter. See MPEP § 2106 II C.

> The subject matter of a properly construed claim is defined by the terms that limit
> its scope. It is this subject matter that must be examined. As a general matter,
> the grammar and intended meaning of terms used in a claim will dictate whether
> the language limits the claim scope. Language that <u>suggests or makes optional</u>
> but does not require steps to be performed or does not limit a claim to a
> particular structure does not limit the scope of a claim or claim limitation. The
> following are examples of language that may raise a question as to the limiting
> effect of the language in a claim:

> > (A) statements of intended use or field of use,
> > (B) "adapted to" or "adapted for" clauses,
> > (C) "wherein" clauses, or
> > (D) "whereby" clauses.

> See MPEP § 2106 II C.

3. Independent claims are examined together, since they are not patentable distinct. If

applicant expressly states on the record that two or more independent and distinct

inventions are claimed in a single application, the Examiner may require the applicant to

elect an invention to which the claims will be restricted.

Claim Objections

Claim 9 is objected to under 37 CFR 1.75(c), as being of improper dependent

form for failing to further limit the subject matter of a previous claim. Applicant is

required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

dependent form, or rewrite the claim(s) in independent form.

MPEP 608.01(n), Section III provides the "Infringement Test" to determine if a

claim is a proper dependent claim: The MPEP states:

> The test as to whether a claim is a proper dependent claim is that it shall include
> every limitation of the claim from which it depends (35 U.S.C. 112, fourth
> paragraph) or in other words that it shall not conceivably be infringed by anything
> which would not also infringe the basic claim.

Claims 9 is an improper dependent claims because it provides for, "A computer-

readable medium bearing instructions for providing forecasting and modeling, the

instructions being arranged, upon execution, to cause one or more processors to

perform the step of a method according to claim 1. " Claim 9 fails the infringement test

because one could infringe claim 9, but not claim 1, by having a computer-readable

medium bearing instructions which upon execution would cause one or more

processors to perform the method of claim 1, but does not do so."

a computer memory medium comprising a computer executable software

program that is capable of executing the method of claims 1 or 21, but does not do so.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine,
manufacture, or composition of matter, or any new and useful improvement
thereof, may obtain a patent therefor, subject to the conditions and requirements
of this title.

Claims 1-8 and 10-18 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

Re Claim 1: Not a proper method (i.e., process) claim.

In order for a method to be considered a "process" under 101, a claimed process

must either: (1) be tied to another statutory class (such as a particular apparatus) or (2)

transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*,

450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v.*

Benson, 409 U.S. 63, 70 (1972); *In re Bilski*, 88 USPQ2d 1385, 1391 and 1396 (2008).

Although the method claim recites the collection of data "over a network," this is

a nominal recitation of another statutory class. The process steps recited in the body of

the claim may be performed by a human operator alone.

Re Claim 10: Software per se

The preamble of the claim suggests that it is directed to a "system" or apparatus

claim. System claims are defined by their structural components and how those

structural components operate together. The claim uses language such as "module"

which is suggestive of software. Note: Dependent claims 11-16 and 18 also use

language apparently directed to software (e.g., mapper, module etc.). Note: If claims

are amended, please indicate where support may be found in the specification.

Dependent claims are rejected based on the same rationale as the claims from

which they depend.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out
> and distinctly claiming the subject matter which the applicant regards as his
> invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claims 1 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being

incomplete for omitting essential elements, essential steps and/or essential structural

cooperative relationships of elements such omission amounting to a gap between the

elements, the steps and/or the necessary structural connections. See MPEP

§ 2172.01. The omitted elements, the steps and/or structural cooperative relationships

are:

The invention described in applicants specification describes the problems

associated with storing spreadsheets as documents and the need and describes the

associated mapping of the spreadsheet as critical to performance of the disclosed

invention. Similarly, the specification describes the novelty of the invention pertaining to

use in simulation. Thus, the limitations of claims 2,3 and 4 are critical to applicants invention and should be recited in the independent claim.

Furthermore, the model depends on the objects, classes for generation.

NOTE: It is unclear whether the limitations of claims 2 and 3 are required together as part of a single invention or if they are alternatives (i.e., species) Applicant should clarify this in the subsequent response. If they are alternatives (i.e., species), an election of species may be required.

Re Claims 1 and 10: The claim recites, "wherein the financial model supports user approval of selected ones of the financial components," See remarks supra on claim interpretation. The limitation raises a question as to the limiting effect of the language in the claim. The "wherein" clause has no bearing on influence of the steps or acts performed by the claimed invention.

Re Claims 2 and 3: Should "a spreadsheet" in the body of the claim be – the spreadsheet -- ?

Re Claims 2 and 11: The claim recites, "wherein the content includes the data and formulas for input into the financial model. See remarks supra on claim interpretation. The limitation raises a question as to the limiting effect of the language in the claim. The "wherein" clause has no bearing on influence of the steps or acts performed by the claimed invention.

Re Claims 3 and 12 The claim recites, " wherein the class duplicates functionality of the spreadsheet if the class is used to create an object." See remarks supra on claim interpretation. The limitation raises a question as to the limiting effect of

the language in the claim. The "wherein" clause has no bearing on influence of the

steps or acts performed by the claimed invention.

Re Claims 7 and 17: The claim recites, "wherein the GUI supports options to

format the report. " See remarks supra on claim interpretation. The limitation raises a

question as to the limiting effect of the language in the claim. The "wherein" clause has

no bearing on influence of the steps or acts performed by the claimed invention.

Re Claims 4 and 13: The claim should recite actually performing a simulation

and not just outputting the simulation result.

Re Claims 8 and 17: There is insufficient antecedent basis for "the response

object", "the second user" limitation in the claim.

Is the "financial model" the same as in claim 1. If so, it should be preceded by –

said -- or – the --.

It is unclear what the "activator" is and what it does?

Re Claims 10: The claim recites a means (or step) plus function limitation that

invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly

link or associate the disclosed structure, material, or acts to the claimed function such

that one of ordinary skill in the art would recognize what structure, material, or acts

perform the claimed function.

Applicant is required to:

a) Amend the claim so that the claim limitation will no longer be a means (or step)

plus function limitation under 35 U.S.C. 112, sixth paragraph; or

b) Amend the written description of the specification such that it clearly links or
   associates the corresponding structure, material, or acts to the claimed function
   without introducing any new matter (35 U.S.C. 132(s)); or

c) State on the record where the corresponding structure, material, or acts are set
   forth in the written description of the specification that perform the claimed
   function. For more information, see 37 CFR 1.75(d) and MPEP 2181 and
   608.01(o0.

Dependent claims are further rejected based on the same rationale as the claims

from which they depend.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed
> or described as set forth in section 102 of this title, if the differences between the
> subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made
> to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was
> made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating
   obviousness or nonobviousness.

Claims 1-3, 9 -12 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the

alternative, under 35 U.S.C. 103(a) as obvious over Thomson, US Pub. No.

2004/0034615.

Re Claims 1, 9 and 10: Thomson discloses method/computer readable

medium/system for providing forecasting and modeling, comprising:

collecting data in a multi-user collaborative environment over a data network (Thomson,

abstract, [0013] [0014] [0015] [0018] [0051] [0055] [0071] [0106] [0107] [0115] [0116]);

and

generating a financial model with re-usable financial components based upon the

collected data, wherein the financial model supports user approval of selected ones of

the financial components (Thomson, abstract, [0013] [0014] [0015] [0018] [0051] [0055]

[0071] [0106] [0107] [0115] [0116]).

Nonfunctional Descriptive Material The fact that the data of the claimed invention

pertains to finance (i.e., financial model, financial components etc.) is nonfunctional and

as no bearing on steps or acts positively recited in the claimed invention).

> Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or compilation of matter. MPEP § 2106.02.

Alternatively, Official Notice is taken that was old and well known to apply

forecasting and modeling techniques to finance.

Documentary Evidence:

Adler, US Pub. No. 2002/0169658.

Analogous Art It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Thomson to provide for providing forecasting and modeling, comprising: collecting data in a multi-user collaborative environment over a data network; and generating a financial model with re-usable financial components based upon the collected data, wherein the financial model supports user approval of selected ones of the financial components.

The claimed invention applies prior art elements according to known methods to yield predictable results; applies a known technique to a known device (method, or product) ready for improvement to yield predictable results; and known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Re Claims 2 and 11: Thomson discloses the claimed invention supra and further

discloses wherein the collected data resides within a spreadsheet, and further

comprising:

mapping content from a plurality of cells of a spreadsheet to a plurality of objects,

wherein the content includes the data and formulas for input into the financial model

(Thomson, abstract, [0013] [0014] [0015] [0018] [0051] [0055] [0071] [0106] [0107]

[0115] [0116]).

Re Claim 3 and 12: Thomson discloses the claimed invention supra and further

discloses wherein the collected data resides within a spreadsheet, further comprising:

mapping content including the data from a plurality of cells of a spreadsheet to one or

more classes, wherein the class duplicates functionality of the spreadsheet if the class

is used to create an object (Thomson, abstract, [0013] [0014] [0015] [0018] [0051]

[0055] [0071] [0106] [0107] [0115] [0116]).

Claims 4-8 and 13-18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Thomson as applied to claims 1 and 10 above, and further in view of

Adler, US Pub. No. 2002/0169658.

Re Claims 4 and 13: Thomson discloses the claimed invention supra but fails to

explicitly disclose

outputting a simulation result from the financial model;

providing a user with a plurality of input parameters including operators;

dynamically receiving one of the input parameters from the user in support of what-if

analysis of the financial model;

and generating another simulation result in response to the received input parameter for

retrieval by the user over the data network.

Adler discloses:

outputting a simulation result from the financial model (Adler, abstract, [0002] [0032]

[0033] [0043] [0045] [0046] [0047] [0048] [0049] [0073] [0083]);

providing a user with a plurality of input parameters including operators (Adler, abstract,

[0002] [0032] [0075] [0076]);

dynamically receiving one of the input parameters from the user in support of what-if

analysis of the financial model (Adler, abstract, [0002] [0032] [0033] [0050] [0075]

[0076]); and

generating another simulation result in response to the received input parameter for

retrieval by the user over the data network (Adler, abstract, [0002] [0032] [0075] [0076]).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the teachings of Thomson by adopting the teachings of

Adler to provide outputting a simulation result from the financial model; providing a user

with a plurality of input parameters including operators; dynamically receiving one of the

input parameters from the user in support of what-if analysis of the financial model; and

generating another simulation result in response to the received input parameter for

retrieval by the user over the data network.

As suggested by Adler, one would have been motivated to assess the risks and
rewards of alternative decisions and to identify the most promising strategy to pursue.

The claimed invention applies prior art elements according to known methods to
yield predictable results; applies a known technique to a known device (method, or
product) ready for improvement to yield predictable results; and known work in one field
of endeavor may prompt variations of it for use in either the same field or a different one
based on design incentives or other market forces if the variations are predictable to
one of ordinary skill in the art. Thus, the claimed subject matter likely would have been
obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Re Claims 5 and 14: Thomson in view of Adler discloses the claimed invention supra
and Adler further discloses performing error checking of the simulation result to
determine absence of a constraint (Adler, abstract, [0002] [0032] [0033] [0043] through
[0049] [0050] through [0052] [0073] [0075] [0076] [0083]).

Re Claims 6 and 15: Thomson in view of Adler discloses the claimed invention supra
and Adler further discloses generating a report of the simulation result via a list query
language module that specifies and executes queries in list algebra (Adler, abstract,
[0002] [0032] [0033] [0043] [0045] [0046] [0047] [0048] [0049] [0073] [0083] [0097]
[0098]).

Re Claims 7 and 16: Thomson in view of Adler discloses the claimed invention supra
and Adler further discloses presenting a graphical user interface (GUI) to a host for

display of the report to the user, wherein the GUI supports options to format the report

(Adler, [0083] [0085] [0086] [0087] [0088] [0091] [0092] [0097] [0098]).

Re Claims 8 and 17: Thomson in view of Adler discloses the claimed invention supra

and Adler further discloses wherein a first user issues a request object for requesting

information relating to financial model, and the request object includes one of an

activator and program to collect the information and to validate a response from the

second user, the response object conforming to a class interface specified by the first

user, the method further comprising:

storing the request object (Adler, abstract, [0002] [0032] [0033] [0050] [0075] [0076]);

and

selectively forwarding the request object to a second user (Adler, abstract, [0002] [0032]

[0033] [0050] [0075] [0076]).

Re Claim 18: Thomson in view of Adler discloses the claimed invention supra and

Adler further discloses a strategy game module configured to solicit input from a

plurality of users to simulate a plurality of scenarios relating to the financial model, the

scenarios corresponding to different competitive goals assigned to the users (Adler,

abstract, [0002] [0032] [0033] [0050] [0075] [0076]).

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to SARA CHANDLER whose telephone number is

(571)272-1186. The examiner can normally be reached on M-F, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Kramer can be reached on (571)272-6783. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

SMC